

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
25746.0018 (formerly 15832.0018)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number

10/828,252

Filed

April 21, 2004

on _____

Signature _____

First Named Inventor

Daniel M. SCHWARTZ *et al.*

Typed or printed

Name _____

Art Unit

2178

Examiner

Joshua D. CAMPBELL

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

**The review is requested for the reason(s) stated on the attached sheet(s). Note:
No more than five (5) pages may be provided.**

I am the

Michael A. Schwartz

☐ applicant/inventor.

Signature

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

Typed or printed name
Michael A. Schwartz

☒ attorney or agent of record.

Telephone number

Registration number 40,161

202-373-6000

☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34

Date

July 24, 2007

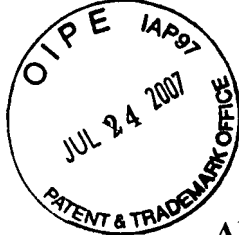
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



"Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**APPLICANT'S REMARKS IN SUPPORT OF THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In the Office Action issued January 26, 2007, claims 1-4, 6-10, 15, and 23-30 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement. Claims 1-4, 6-10, 15, and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. 2002/0035697 to McCurdy et al. (McCurdy) in view of US Patent Number 6,915,484 to Ayers et al. (Ayers) further in view of Adobe Creative Team, "Adobe Acrobat 4.0 Classroom in a Book, second edition, published on January 4, 2000 (ACT).

The Applicant respectfully traverses the Examiner's rejections. The claims as currently amended do comply with the enablement requirement and the cited references fail to anticipate or obviate the instant claims. In particular, the Applicant believes that the Examiner has failed to make out a prima facie case of obviousness because the Examiner has incorrectly identified particular portions of the references as disclosing required elements of the claims.

Regarding the rejection under 35 U.S.C. 112, first paragraph, claims 1 and 15 recite "...electronically laying out during design of a digital magazine a plurality of pages to form the digital magazine, such that each single page fully fits a selected one of either a landscape format or a portrait format display screen," while the specification at paragraph [0042] discloses the text and graphics, i.e., all the viewable features, of each page of the magazine are designed (laid out) to fill a full display screen in the landscape format, e.g., in a height:width (aspect) ratio of 3:4. Similarly, if a portrait format is desired, the text and graphics are laid out for full-screen viewing in an aspect ratio typical of a portrait-oriented display screen, e.g. 4:3. The Examiner states that the claim recitation is not enabled because "the specification does not provide any evidence that each page will fully fit a display screen at the time of design. For instance, if the screen used by

the use did have the typical aspect ratio of 3:4 or 4:3, which is the case with all widescreen TVs and computer display screens that are 16:9, the pages would not fully fit the display screen.” However, the claim language does not claim that the digital magazine pages are designed to fully fit any possible display screen. Rather, what is claimed is that the digital magazine pages are designed to fit a particular display screen, namely “a selected one of either a landscape format or a portrait format display screen.” That is clearly enabled.

The applicant respectfully submits that the present invention, according to claims 1-4, 6-10, 15, and 23-30 is not obvious over McCurdy in view of Ayers and further in view of ACT. McCurdy discloses systems and methods for distributing and viewing electronic documents. In particular, at paragraphs [0014], [0200], and [0203], McCurdy discloses displaying a document in landscape or portrait mode. However, the present invention, for example, according to claim 1, requires electronically laying out during design of a digital magazine a plurality of pages to form the digital magazine, such that each single page fully fits a selected one of either a landscape format display screen, so that each page is displayable in a full-screen manner without borders and with any toolbars of a display program hidden, and wherein the page can be read without zooming, scrolling, or page scrolling. McCurdy does not disclose or suggest laying out pages during design of a digital magazine to meet the requirements of this claim. In particular, McCurdy discloses a two page reading layout of the electronic magazine or display of a single page with borders, and discloses toolbars displayed to allow zooming, scrolling and page scrolling.

Ayers discloses a method and computer program product for reflowing a PDL page without using the original application used to create the PDL page. Again, Ayers does not

disclose or suggest laying out pages during design of a digital magazine to meet the requirements of this claim.

ACT discloses that the opening display of a document may be set to Full Screen mode with toolbars hidden. ACT discloses a full screen mode in which the document is displayed at whatever zoom setting is needed so that the longest dimension of the document exactly fits the corresponding dimension of the display. Further, ACT discloses hiding the toolbars so that the document cannot be zoomed, scrolled, etc. Disclosure of preventing the capability of zooming, scrolling, etc. is not disclosure of designing a document so that it can be read without the need to zoom, scroll, etc. Thus, nothing in ACT discloses or suggests that the document is designed so that each single page fully fits a selected one of either a landscape format or a portrait format display screen (both dimensions exactly fit both dimensions of the display screen) and wherein the page can be read without zooming, scrolling, or page scrolling (text and image sizes and layout are selected during design).

Even if McCurdy, Ayers, and ACT were combined as suggested by the Examiner, the result still would not be the present invention, as claimed. The combination of McCurdy, Ayers, and ACT still does not disclose or suggest a document that meets all the requirements of the claims. For example, for claim 1, the combination of McCurdy, Ayers, and ACT does not disclose or suggest laying out during design of a digital magazine pages such that each single page fully fits a display screen, so that each page is displayable in a full-screen manner without borders and wherein the page can be read without zooming, scrolling, or page scrolling. Likewise for claim 15, the combination of McCurdy, Ayers, and ACT does not disclose or suggest electronically laying during design of a digital magazine out a plurality of pages to form digital magazine, such that each page fully fits a landscape format display screen,

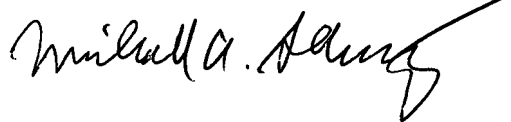
so that each page is displayable in a full-screen manner without borders and with any toolbars of a display program hidden, and wherein the page can be read without zooming, scrolling, or page scrolling;

Thus, the present invention, according to claim 1, and according to claim 15, which is similar to claim 1, and according to claims 1-4, 6-10, 15, and 23-30, which depend therefrom, is not unpatentable over McCurdy in view of Ayers, and further in view of ACT.

For at least these reasons, the claim rejections are improper and must be withdrawn.

While no fee is believed due in conjunction with these Remarks or the underlying Request, the Commissioner is hereby reauthorized to charge any insufficiency or credit any overpayment associated with this application to Bingham McCutchen LLP Deposit Account No. 50-4047 (order no. 25746.0018). The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner or a member of the reviewing Panel feel further communication would help prosecution, such Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



Michael Schwartz
Reg. No. 40,161

Dated: July 24, 2007

Bingham McCutchen LLP
2020 K Street, NW
Washington, DC 20006
(202) 373-6000 Telephone
(202) 373-6001 Facsimile